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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91228461
Party	Defendant Headball Records LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 86/714,576

Mark: Design Only

Application Filing Date: August 4, 2015

Skullcandy, Inc.)	Opposition No. 91228461
)	
Opposer,)	
)	
v.)	
)	
Headball Records, LLC)	
)	
Applicant.)	
_____)	

**APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS FOR
OPPOSITION PROCEEDING NO. 91228461**

Applicant Headball Records, LLC ("Applicant") hereby moves for judgment on the pleadings dismissing the instant opposition against Applicant's U.S. Application Serial No. 86/714,576 ("the '576 Application") pursuant to Rule 12(c) of the Federal Rules of Civil Procedure on the ground that, as a matter of law, Applicant's Design mark is not confusingly similar in appearance, sound, meaning, or commercial impression to the mark shown in U.S. Registration Nos. 3,168,754 and 4,622,095 pleaded and relied on by Opposer, Skullcandy, Inc. ("Opposer"). Further, because the marks are completely dissimilar, Opposer's second claim for dilution under Section 43(c) fails as a matter of law and should also be dismissed with prejudice as to the '576 Application.

Statement of Facts

1. Applicant seeks to register its Design mark for "*Pre-recorded records, compact discs, DVDs and audio/visual discs, all featuring music; musical sound recordings; audiovisual recordings featuring music and musical based entertainment; downloadable musical sound and downloadable audiovisual recordings featuring music and musical based entertainment; sound recordings featuring music; video recordings featuring music; digital music downloadable from the Internet; video recordings featuring musical artists; audio recordings featuring music*" in International Class 9 and "*Entertainment services in the nature of providing information relating to music and entertainment via a global computer network; providing online entertainment, namely, providing non-downloadable sound and audiovisual recordings in the field of music and musical based entertainment; providing a website over a global computer network featuring information on musical artists; providing information about performances to be given by musical artists on tours; production of sound recordings; providing information about popular culture and events and musical based entertainment; production of music; production and publishing of music; fan clubs; audio and sound recording and production; record production; entertainment services, namely, production of music concerts before live audiences; entertainment services, namely, providing a web site featuring musical performances, non-downloadable musical videos, related film clips, and photographs; entertainment services, namely, providing on-line non-downloadable articles on musical artists and music videos; entertainment services, namely, providing prerecorded music, information in the field of music, and articles about music, all on-line via a global computer network and non-downloadable; entertainment services in the nature of*

recording, production and post-production services in the field of music; Production of sound recordings; Production of musical sound recordings; Entertainment services in the nature of presenting live musical performances” in International Class 41 (Application Serial No. 86/714,576).

2. The mark (“Applicant’s Mark”) depicted in the ‘576 Application is as follows:



3. Opposer filed a Notice of Opposition challenging registration of the ‘576 Application alleging that Applicant’s Mark therein is likely to cause confusion with its design mark of Reg. No. 3168754 and Reg. No. 4622095.

4. The goods registered in Opposer’s ‘754 Registration are for "*Devices for hands-free use of mobile phones; Digital audio players; Digital phones; Earphones; Headphones; MP3 players; Portable listening devices, namely, MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets*" in International Class 9.

5. The goods registered in Opposer’s ‘095 Registration are for "*Audio speakers; portable speakers; speaker docks; dock speakers for mobile audio players; headsets for*

use with computers; audio equipment for use in connection with helmets, namely, speakers, headphones, earphones, and microphones that can be attached to or integrated into a helmet; cases for mobile phones and cell phones” in International Class 9, “Clothing, namely, jackets; outerwear, namely, coats, sweatshirts; socks; footwear” in International Class 25, “Headsets for use with game consoles and video games; audio and visual headsets for use in playing video games; gaming headsets adapted for use in playing video games” in International Class 28, and “Custom design of products based on personal selections made by consumers, namely, devices for hands-free use of mobile phones, earphones, headphones, portable speakers, headsets for use with computers, game consoles and video games; custom design of products, namely, devices for hands-free use of mobile phones, earphones, headphones, portable speakers, headsets for use with computers, game consoles and video games based on personal selections made by consumers through the temporary use of a web-based software application” in International Class 42.

6. The mark (“Opposer’s Mark”) depicted in the both the ‘754 and ‘095 Registrations is as follows:



7. Opposer also alleges in the Notice of Opposition that it has its Opposer's Mark in connection with *“advertising, promotion, offer and sale of various goods and services, including without limitation headsets, headphones, ear buds, earphones, portable speakers, musical sound recordings, audiovisual recordings featuring music, downloadable music and audiovisual recordings featuring music, video recordings featuring music and musical artists, digital music downloadable via the Internet and mobile applications; entertainment services, including providing information relating to music, music artists, music events and entertainment via the Internet and mobile applications, production and publishing of music and sound recordings, production of festivals and concerts and non-downloadable musical videos”*.

No Likelihood of Confusion under Section 2(d) or Dilution under Section 43(c)

The Respective Marks of the parties are so dissimilar that any chance of confusion under Section 2(d) or dilution under Section 43(c) is highly remote, if not non-existent.

A simple comparison of the visual features of the marks shows that they are utterly dissimilar in appearance, sound, meaning, and commercial impression, which precludes a finding of likelihood of confusion or dilution. See In re E.I. DuPont DeNemours & Co., 177 USPQ 563 (CCPA 1973). For ease of comparison, the above displayed marks are again displayed together side by side below:



Even viewing all other DuPont factors in Opposer's favor, which Applicant concedes them only for the purposes of this motion, the dissimilarities between the respective marks are so great as to avoid likelihood of confusion or dilution. The Board may reach this conclusion based on a consideration of the dissimilarity of the marks alone. See Kellogg Co. v. Pack'em Enterprises, Inc., 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)(single du Pont factor of dissimilarity of marks outweighed all others such that other factors, even if decided in nonmovant's favor, would not be material because they would not change the result). Accordingly, Applicant's Motion for Judgment on the Pleadings should be granted, and the opposition should be dismissed with prejudice as to Applicant's '576 Application.

Legal Standard

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion only, all well pleaded factual allegations of the non-moving party must be accepted as true. Conclusions of law are not taken as admitted.

Baroid Drilling Fluids Inc. v. SunDrilling Products, 24 USPQ2d 1048 (TTAB 1992). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.* A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Id.*

The Marks Are Dissimilar in Appearance, Sound, Meaning, and Commercial Impression

The Lanham Act prohibits registration of a mark on the Principal Register that would create a likelihood of confusion. 15 U.S.C. § 1052(d). Whether a mark is likely to cause confusion under Section 2(d) is a question of law. Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1565, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987); Monarch Marking Systems, Inc. v. Elan Systems, Inc., 39 U.S.P.Q.2d 1035 (TTAB 1996); Blansett Parmacal Co. Inc. v. Carmic Laboratories, Inc., 25 U.S.P.Q.2d 1473, 1476 (TTAB 1992); Blue Cross and Blue Shield Ass'n v. Harvard Community Health Plan, Inc., 17 U.S.P.Q. 1075 (TTAB 1990). "[O]ne DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." See Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (court affirms Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); Kellogg Co. v. Pack'em Enterprises, Inc., *supra* (court affirms Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 5 (Fed. Cir. 1989)(court affirms Board dismissal of opposition based on dissimilarity of the marks

PECAN SANDIES and PECAN SHORTEES). See also Missiontrek Ltd. Co. v. Onfolio, Inc., 80 USPQ2d 1381 (TTAB 2005) (dissimilarity of the marks ONFOLIO and design and CARTAGIO dispositive); Sears Mortgage Corp. v. Northeast Savings F.A., 24 USPQ2d 1227 (TTAB 1992) (dissimilarity between the marks APPROVAL PLUS and APPROVALFIRST dispositive).

The similarity or dissimilarity of the marks must be analyzed by comparing the marks in their entireties, as to appearance, sound, connotation and commercial impression. In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Further, no element of a mark can be ignored when analyzing the likelihood of confusion issue. In re Electrolyte Labs., Inc., 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990), citing Spice Islands, Inc. v. Frank Tea & Spice Co., 505 F.2d 1293, 184 USPQ 35 (CCPA 1974).

In the instant opposition, the respective marks are completely different in appearance, sound, meaning, and commercial impression, which precludes a finding of likelihood of confusion. See In re E.I. DuPont DeNemours & Co., 177 USPQ 563 (CCPA 1973). Further, Applicant respectfully submits that it has adequately met its burden in establishing the absence of any genuine issues of material fact. The circumstances here are similar to those in Kellogg Co. v. Pack'em Enterprises, Inc., 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in that the single DuPont factor of the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion. For the purposes of this motion only, the Board may even consider the other DuPont factors, such as the relationship between the goods and the alleged fame of Opposer's mark, in

Opposer's favor. By Applicant's concession of these other factors for this motion only, they are not in dispute for deciding the instant motion. However, even viewing all other DuPont factors in Opposer's favor, the dissimilarities of the marks are so great as to avoid likelihood of confusion or dilution.

1. Appearance

It is instantly clear that Opposer's Mark and Applicant's Mark are dissimilar in appearance. As described in the '576 Application Applicant mark consists of a ball partially formed with a face and with a shadow appearance underneath the ball. A large portion of the ball has the appearance of a soccer ball (i.e. hexagon and pentagon shaped patterns forming the outer surface) and a detailed face comprising the remaining portion of the ball. The face portion is deformed inward at the mouth area with the mouth area appearing closed and detailed to give the appearance of teeth. The face also includes a nose area which appears punched in and two eye areas, with each eye area having a shape similar to a conventional eyeglass lens. The design also includes the shadow appearance underneath the ball.

Though Opposer refers to its mark as a skull, in reality the design appears more like a mask and such as an alien mask that could be held in place by the two prongs extending from the bottom. Whether Opposer's mark is considered a skull or not, it is still significantly different and distinguishable from Applicant's mark. Opposer's mark is very basic in design, especially when compared to the highly detailed design of Applicant's mark. Opposer's Mark merely provides two eye cutouts, with at least one being circular, and a nose cutout. No mouth area (whether detailed or basic) is provided in Opposer's Mark.

When reviewing Opposer's Mark it is quite clear that none of the above-described features for Applicant's Mark are present in Opposer's Mark. Because Opposer's Mark does not share any of these main features of Applicant's mark (as well as other differences between the marks immediately noticeable when reviewing the marks), the respective marks are not similar in appearance, and confusion between the respective marks and dilution of Opposer's marks is not likely and in fact highly unlikely.

2. Sound

As both marks are design marks, neither mark has a sound. The ball component is a significant part of Applicant's mark. As Opposer's Mark has no "ball" component, no individual would ever describe Opposer's Mark by the word "ball". Accordingly, though neither mark contains any wording, if one was to verbally describe the respective marks, their descriptions would be dissimilar.

3. Meaning

Similar to Applicant's arguments for "Sound", both marks are design marks only and don't contain any wording. Applicant's mark is heavily emphasized on its ball component. Opposer's Mark does not contain a ball. As such, no individual could interpret Opposer's mark to be a "ball". Accordingly, to the extent the respective marks can be defined, they are dissimilar in meaning.

4. Commercial Impression

Applicant's and Opposer's marks create completely different commercial impressions. Applicant's Mark creates the impression of a ball having a face formed as part of the ball. Opposer's Mark does not contain any of these elements and does not

create a similar commercial impression. The Opposer's Mark will never be considered to be a ball or to have a ball portion as part of its design.

Overall, the marks are dissimilar in appearance, sound, meaning, and create dissimilar commercial impressions. See Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (court affirms Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); Kellogg Co. v. Pack'em Enterprises, Inc., supra (court affirms Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (court affirms Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES). See also Missiontrek Ltd. Co. v. Onfolio, Inc., 80 USPQ2d 1381 (TTAB 2005) (dissimilarity of the marks ONFOLIO and design and CARTAGIO dispositive) and Sears Mortgage Corp. v. Northeast Savings F.A., 24 USPQ2d 1227 (TTAB 1992) (dissimilarity between the marks APPROVAL PLUS and APPROVALFIRST dispositive).

Thus, the overall impression is of dissimilar marks. Even if Opposer's mark is considered famous (for purposes of this Motion only), and even if all the other du Pont factors were to be considered in Opposer's favor (for purposes of this Motion only), including the similarity of the goods, channels of trade and classes of consumers, the marks in this case are simply too dissimilar to support a finding of likelihood of confusion. See Kellogg, 14 USPQ2d at 1550 (dissimilarity of marks outweighed all other du Pont factors, even if opposer were to offer evidence of mark's fame).

In view of the clear differences between the marks, there is no likelihood of confusion or dilution as a matter of law. The Board may reach this conclusion solely by comparing the marks for dissimilarities in appearance, sound, meaning, and commercial impression. It is beyond dispute that Applicant's and Opposer's respective marks contain completely different features. The differences are so great as to preclude a likelihood of confusion under Section 2(d) or dilution of Opposer's Marks under Section 43(c). Accordingly, the Notice of Opposition should be dismissed, with prejudice, as to Applicant's '576 Application.

Applicant also anticipates Opposer to argue that the respective marks are similar because they both contain skull portions. While Applicant strongly disagrees with this position, assuming this argument to be true for this Motion only, such argument still fails to establish a likelihood of confusion or dilution. The anticipated argument ignores the fact the respective designs, including the alleged skulls, when viewed as a whole (as required), are entirely different. Thus, a likelihood of confusion or dilution cannot exist as a matter of law and that this case should be decided based on the first *du Pont* factor alone as being dispositive. *See, e.g., Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Conclusion

Based on the foregoing, Applicant's Motion for Judgment on the Pleadings should be granted, and the instant opposition (Proceeding No. 91228461) should be dismissed, with prejudice, in its entirety as to Applicant's '576 Application.

WHEREFORE, Applicant respectfully prays:

- (1) That the Board dismissed the Notice of Opposition in its entirety in favor of Applicant, with prejudice, on all of Opposer's allegations and alleged claims;
- (2) That the Board find that Opposer has brought this Opposition proceeding in bad faith and with unclean hands;
- (3) That the Board provide or award Applicant any other relief that it deems just.

WHEREFORE, Applicant respectfully requests that Opposition No. 91228461 be dismissed in its entirety with prejudice.

Dated this 9th day of August, 2016.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of August 2016, a true copy of the foregoing APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS FOR OPPOSITION PROCEEDING NO. 91228461 was served via First Class U.S. Mail, addressed as follows:

Christopher M. Dolan, Esq.
Barnes & Thornburg
One North Wacker Drive
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Chicago, Illinois 60606

Executed on August 9, 2016.

/Daniel S. Polley/
Daniel S. Polley, Reg. No. 34,902